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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,837	09/09/2003	Mark A. Reiley	9448.17205-CIP DIV 6	1759

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EXAMINER
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ISABELLA, DAVID J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/657,837

**Applicant(s)**

REILEY, MARK A.

**Examiner**

DAVID J. ISABELLA

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,10 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,9,11-19,23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of the Claims***

Claims 1-29 are pending. Claims 1,2,4-6,8,9,11-19,23-29 are pending for consideration. Claims 3,7,10,20-22 have been withdrawn as being directed to a non-elected species/invention. Claims 1,3,7,24,25 and 29 have been amended.

***Response to Arguments***

Applicant's arguments filed 6/12/2006 have been fully considered but they are not persuasive. Applicant argues that the device of Zang et al is directed to a completely different joint and there is no motivation that the joint would be capable of functioning in the spinal structure. Moreover, applicant has amended claim 1 to further clarify the application of the claimed invention to the spine by reciting that the prosthetic facet joint articulating surface is dimensioned to replace all or a portion of a natural facet joint on the vertebra. Applicant further argues that Zang does not describe how any of the components of his metatarsal-phalangeal devices are dimensioned to replace all or a portion of a natural facet joint.

Examiner maintains that the claims as broadly worded fails to set forth specific structural features that positively defines the implant that unique to the spinal environment. Moreover, the language of "prosthetic facet joint articulating surface is dimensioned to replace all or a portion of a natural facet joint" fails to limit the same. Is the device that replaces all of the natural facet joint identical to that which replaces only a portion of the natural facet joint? Applicant is arguing that the spinal joint is dimensioned to be used in a spinal facet joint, yet specific structural and/or dimensional recitations are not found in the specification. Accordingly, the device of Zang, et al is

structurally similar to the device as claimed by applicant and therefor remains capable of providing the same function and intended use as claimed by applicant.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4-6,8,9,11-17,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Zang et al (5314486)

Zang, et al discloses a prosthesis comprising a fastenting element, and an artificial joint structure carried by the fastening element. While the prosthesis of Zang, et al is intended for replacement of a phalangeal type joints, the structure as broadly claimed is fully met by the prosthesis of Zang, et al. The prosthesis of Zang, et al is structurally similar to that as illustrated by applicant. Therefor, examiner contends that the device of Zang et al is capable of performing the function of replacing all or a portion of the natural facet joint.

Claim 2, the facet joint of Zang,et al is fixed to the fastening element.

Claims 4-6, see element 70 or 44 of Zang, et al.

Claims 8 and 9, see insert of Zang, et al.

Claims 11-17,19 see cooperating elements of Zang et al.

The prosthesis of Zang, et al is fabricated from selected biocompatible materials including titanium, cobalt chrome and may be fastened to the bone by with roughen surface providing a bone in-growth surface medium.

Claim 23, see elements 70 or 44.

Claims 26 and 27 as broadly worded fails to structurally distinguish over the prosthetic as disclosed by Zang, et al.

Claims 28 and 29, the prosthesis of Zang, et al is fabricated from selected biocompatible materials including titanium, cobalt chrome and may be fastened to the bone by with roughen surface providing a bone in-growth surface medium.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zang,et al (5314486) as applied to claim 1 above, and further in view of Johnson et al (5609641).

The combination of the fastening element and the facet joint structure of Zang et al is illustrated to be one piece. It is well known in the art to fabricate the elements, fastening and the joint structure independently to be joined later by the surgeon, as shown for example by Johnson, et al. Independent elements allow for better sizing and

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matching of the prosthesis to the in vivo bone structure. In view of Johnson, et al, to fabricate the one piece prosthesis of Zang, et al out of two pieces would have been obvious to one with ordinary skill in the art as the independent pieces allows the surgeon greater flexibility.

Claim 18, whether natural fixation or cement fixation (Johnson, et al) is used, the two are essentially known equivalents in the art. Moreover, the manner by which the prosthesis is fixed to the bone, as claimed, does not further limit the structure of the device as broadly worded.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zang et al as applied to claim 1 above, and further in view of Carignan, et al (4955916).

The insert of Zang et al is shown to be mechanically fixed to the fastening element. Carignan et al shows the same fixation of the insert to the fastening element using a morse taper connection. To connect the insert to the fastening element of Zang, et al with a morse taper connection would have been obvious to one with ordinary skill in the art as being essentially equivalent means for fixing an insert to a main component.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

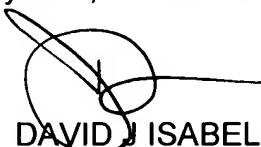
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. ISABELLA whose telephone number is 571-272-4749. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J. ISABELLA  
Primary Examiner  
Art Unit 3738

DJI  
8/18/2006